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OF THE TTAB

Paper No. 20
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Infonxx, Inc.

Serial No. 75/270,326

James S. Blank and Nicholas G. Mehler of Latham & Watkins
for Infonxx, Inc.

Wanda Kay Price, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Simms, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Infonxx, Inc. seeks registration of the mark PERSONAL
PAGES for "telephone directory information services."¹

The Trademark Examining Attorney has finally refused
registration on the ground that applicant's mark is merely
descriptive of its services, under Section 2(e)(1) of the
Trademark Act, 15 U.S.C. §1052(e)(1).

¹ Application Serial No. 75/270,326, filed on April 7, 1997,
based upon an allegation of a *bona fide* intention to use the mark
in commerce on the goods as recited above in Int. Cl. 35.

Applicant has appealed. The case has been fully briefed. Although applicant had initially requested an oral hearing before this Board, it later waived this opportunity.

The Trademark Examining Attorney argues that the mark PERSONAL PAGES merely describes a *feature* of applicant's services. In support of this position, she has placed into the record stories from the LEXIS/NEXIS database retrieved from several distinctly different search strategies.²

On the other hand, applicant contends that the Trademark Examining Attorney has failed to demonstrate that the mark as a whole is merely descriptive of applicant's telephone directory information services.

Based upon careful consideration of the record in this application, we agree with applicant, and find that the Trademark Examining Attorney had *not* met her burden of establishing that the mark as a whole is merely descriptive of the services recited in the application.

It is well settled that a term is considered to be merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information

² The initial query sought the combined term "personal pages" while later queries sought the word "pages" in NEXIS text within a proximate distance of the term "telephone directory."

about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is being used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. On the other hand, the immediate idea must be conveyed with some "degree of particularity." In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991); and In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1987).

Furthermore, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). We must look to the context in which the term is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services

because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See In re Abcor Development Corp., *supra* at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corporation of the Americas, *supra* at 58. The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

As we examine the evidence placed into the record by the Trademark Examining Attorney, a brief review of the history of this case is in order. In the first Office action, the Trademark Examining Attorney did not find the

matter descriptive, but did request a disclaimer of the word "pages." Then in a supplemental Office action, the Trademark Examining Attorney refused the entire term as being merely descriptive of the services, including as proof the results of a LEXIS/NEXIS search. While this attached evidence demonstrated uses of the phrase "personal pages," most of these uses were in connection with Web site pages.

Then in her Final refusal, the Trademark Examining Attorney focused on the term "pages" as used in connection with printed products in the nature of telephone books. In these LEXIS/NEXIS excerpts, the publications were referred to as "white pages," "yellow pages," etc. Based upon this use of the word "pages," she argues in her Final refusal as follows:

It is well settled in the relevant telecommunications or telephone trade or industry that 'pages' (whether yellow or white pages) are synonymous with telephone directories. Also, the applicant's attention is directed to the applicant's submitted additional literature in which it is stated, inter alia, that the applicant provides telephone directory assistance for direct connection or access to users' personal numbers. (emphasis in original)

However, applicant contends on appeal that the Trademark Examining Attorney has failed to meet her burden of proof with respect to the mere descriptiveness of the

mark PERSONAL PAGES, as a whole. Applicant points to the fact that the Trademark Examining Attorney has made of record no evidence of any competitors' descriptive usage of the combined term. Rather, applicant argues that one must conduct a multistage reasoning process to connect the term PERSONAL PAGES to the recited telephone directory information services.

We learn from applicant's literature that applicant contracts with large enterprises. Its services are offered to the employees of large corporations and to the subscribers of cellular telephone companies. Applicant's service depends upon the availability of hundreds of actual telephone operators. Relying upon personalized telephone contacts with these operators, cellular telephone users (i.e., who are the beneficiaries of the enterprise contracts with applicant) are offered nationwide directory assistance with automatic connections to other cellular telephones.

Applicant's proposed services include personalized operator relationships and the ability of applicant to store and retrieve a private contact list provided by the subscriber. Hence, the word "Personal" alone may suggest the personalized or private nature of applicant's recited services, but the evidence does not show that it will

immediately convey information about the nature of the service. Furthermore, the question in this appeal is whether the combined term, "PERSONAL PAGES," is merely descriptive for applicant's directory assistance services.

Clearly, applicant's services have nothing to do with personal pages on a Web site. Yet this is the only context in which these two words appear together in the excerpts from the LEXIS/NEXIS database. Furthermore, applicant's services are not connected with white pages of local and regional telephone directories.

The issue presented by this appeal is not whether the asserted mark merely describes bound telephone directories of cellular telephone users, or even their computerized analogues. The mark must be considered in relation to applicant's directory information services. Yet with respect to alphabetical listings and classified directories, each of the Trademark Examining Attorney's LEXIS/NEXIS excerpts attached to the Final refusal uses the phrase "white pages" and/or "yellow pages" to refer to telephone directories in the nature of books - not operator-based, directory assistance services. As applicant stressed throughout the prosecution of this application, applicant's services are not hard-copy telephone books, or even a computerized, online analogue.

Given widespread use of expressions like "white pages," "yellow pages," "classified pages," "telephone business pages," "telephone community pages," etc., we acknowledge that in this context, usage of the word "pages" may be vaguely suggestive of the informational nature of these services.

Even if we were to find that the word "pages" alone (i.e., apart from the phrase "white pages." "yellow pages," "classified pages," etc.) would be readily understood as a reference to telephone directories or phone books generally, applicant does not offer telephone directories or a Web analogue (*contra* Trademark Examining Attorney's appeal brief, p. 4). Accordingly, we find that the term "Pages" in applicant's mark does not describe applicant's services. Furthermore, in her appeal brief, the Trademark Examining Attorney adopts the nomenclature of "directory ('pages') services." (see Trademark Examining Attorney's brief, pp. 6-7). However, the Trademark Examining Attorney's juxtaposition of terms does not prove that "pages" is a shorthand expression for the directory information services provided by telephone operators one reaches by calling the appropriate telephone information number. Rather, the Trademark Examining Attorney appears to be speculating about how broad a connotation to accord

the word "pages" within applicant's mark and we find no evidence in the file to support this leap. Accordingly, we conclude that the Trademark Examining Attorney has not established on the record before us that the mark PERSONAL PAGES is merely descriptive of the identified services.

Applicant's combination of the two words, "Personal Pages," creates a term for which, on this record, we must conclude that there is no third-party usage for this type of services (i.e., other than applicant's mark). The Trademark Examining Attorney has produced no evidence of usage in the United States of the combined term "personal pages" by others in the field of telephone directory assistance.

Accordingly, on the basis of the limited record before us, we find insufficient evidence to hold the term PERSONAL PAGES, as a whole, merely descriptive when used in connection with applicant's enhanced directory assistance services. We conclude that a multistage reasoning process or imagination would be necessary in order for customers or prospective purchasers of these services to conclude anything meaningful about the features of such services. The term PERSONAL PAGES, when used in connection with directory assistance services, has not been shown to immediately or directly describe any significant feature or

aspect of applicant's particular services. Based upon applicant's recited services, we agree with applicant that, while PERSONAL PAGES may be suggestive of the identified services, it is not merely descriptive thereof.

Decision: The refusal to register on the basis of mere descriptiveness is reversed.